

IN THE UNITED STATES TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 2,227,005

For the Trademark: GO GIRL

75137827

Date Registered: March 3, 1999

NOR-CAL BEVERAGE CO., INC.

Petitioner,

v.

IRENE J. ORTEGA, dba GOGIRL ACTIVEWEAR

Respondent.

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) Cancellation No.
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PETITION TO CANCEL

Petitioner NOR-CAL BEVERAGE CO., INC. (hereinafter, "NOR-CAL"), is a corporation organized and existing under the laws of the State of California, and having a mailing address of 2286 Stone Boulevard, West Sacramento, California 95691.

To the best of Petitioner's knowledge, the name and address of the current owner of Reg. No. 2,227,005, according to the electronic records maintained at tarr.uspto.gov, are: Irene J. Ortega, 44032 Eaglebluff Court, Temecula, California, 92592.

The above-identified Petitioner believes that it has been damaged and will continue to be damaged by the continuing existence of Reg. No. 2,227,005, and hereby petitions to cancel the

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same. The grounds for cancellation are as follows:

REGISTRATION SUBJECT TO CANCELLATION

OWING TO REGISTRANT'S FAILURE TO FILE A § 8 AFFIDAVIT OF USE

1. Petitioner NOR-CAL bottles and cans non-alcoholic beverages for the consumption by the general public. Since May 2005, NOR-CAL has marketed and distributed an energy drink under the trademark GO GIRL®. NOR-CAL owns Federal Registration No. 3,235,947 ("the '947 Registration") for GO GIRL, for Non-Alcoholic Beverages, Namely, Energy Drinks.

2. Subsequent to the grant of the '947 Registration, and in connection with the advertising and promotion of its GO GIRL energy drink product, NOR-CAL began producing a line of clothing and small promotional items identified with the term GO GIRL SUGAR FREE ENERGY DRINK.

3. In early 2007, NOR-CAL first became aware of Federal Trademark Reg. No. 2,227,005 ("the '005 Registration"), issued on March 2, 1999, for GO GIRL, in connection with Clothing And Headgear For Women And Girls, Namely, Hats, Caps, Sweatshirts, Sweatpants, Leggings, T-Shirt, Shirts And Shorts. A search of the USPTO online electronic records indicated that by way of Assignment, Respondent IRENE J. ORTEGA was the current owner of the '005 Registration.

4. On information and belief, Respondent IRENE J. ORTEGA, dba GOGIRL ACTIVEWEAR, (hereinafter "ORTEGA") is an individual, residing at 44032 Eaglebluff Court, Temecula, California 92592. ORTEGA claims to own the '005 Registration.

5. Shortly after it first became aware of the '005 Registration, NOR-CAL contacted

ORTEGA and attempted both to purchase, and later to become licensed under, the '005 Registration. ORTEGA refused both of NOR-CAL'S offers, and instead issued through her attorney, a letter to NOR-CAL including a claim of trademark infringement and making a cease and desist demand. ORTEGA'S claim and demand have caused damage to NOR-CAL, and will continue to cause damage to NOR-CAL, as they thwart NOR-CAL'S efforts to promote its energy drink. In addition, ORTEGA'S claim and demand create an unacceptable risk of potential liability to NOR-CAL for the continuing distribution of its clothing and promotional items displaying the term GO GIRL SUGAR FREE ENERGY DRINK thereon.

6. The '005 Registration was originally granted to Girl World Sports, Inc., a Texas corporation. Based upon the current public records of the Texas Secretary of State's Office, World Sports, Inc. was granted its corporate charter on or about March 8, 1996.

7. On or about March 23, 2001, the corporate charter of Girl World Sports, Inc. was forfeited, *inter alia*, because Girl World Sports, Inc. had failed, "...to file a current year franchise tax report to establish the existence of assets from which a judgement for the franchise taxes, penalties and court costs may be satisfied." From said date of forfeiture to the present, Girl World Sports, Inc. has failed or refused to revive its right to do business in the State of Texas, or elsewhere, and is "not in good standing" as it has not satisfied all state tax requirements.

8. From the date the corporate charter of Girl World Sports, Inc. was forfeited until the present, Girl World Sports, Inc. has lacked the legal capacity to enter into any contracts with other parties. Any contract executed by or on behalf of a corporation which lacks legal capacity is void, and may not be enforced under any circumstances.

9. On information and belief, on or about June 22, 2001, after the corporate charter

of Girl World Sports, Inc. was forfeited, an Assignment of the '005 Registration was executed by one "Sasha Milby", represented as the Vice-President of Girl World Sports, Inc. The Assignment purported to transfer ownership of the '005 Registration, and all right, title, and interest in and to the mark GO GIRL, together with the good will of the business symbolized by the mark, to ORTEGA. This Assignment was subsequently recorded in September 2001, in the USPTO Assignment Branch.

10. Because Girl World Sports, Inc. lacked the legal capacity to enter into a contract on June 22, 2001, the aforementioned Assignment, dated June 22, 2001, was void and legally ineffective to transfer any trademark rights including ownership of the '005 Registration, to ORTEGA. Accordingly, Girl World Sports, Inc. retained ownership of the '005 Registration after June 22, 2001, notwithstanding the execution and recordation of said Assignment.

11. Pursuant to the provisions of 15 U.S.C. § 1058, the owner of a Federal Registration has an affirmative obligation to file an Affidavit Of Use in the Office, prior to the end of 6 years following the date of registration. Upon failure to comply with this obligation, the registration shall be canceled by the Director.

12. Girl World Sports, Inc. filed no Section 8 Affidavit Of Use respecting the '005 Registration, and failed therefore to comply with 15 U.S.C. § 1058.

13. On or about November 30, 2004, ORTEGA'S attorney filed an Affidavit Of Use respecting the '005 Registration. However, neither ORTEGA nor ORTEGA'S attorney was the owner of the '005 Registration at that time, or at any time, and moreover both lacked the legal capacity to act on behalf of Registrant Girl World Sports, Inc.

14. Since no Section 8 Affidavit Of Use has ever been filed by the owner of the '005 Registration, and the deadline for filing same has long since passed, the '005 Registration is subject

to cancellation, and should be cancelled forthwith by the Director.

15. Owing to the foregoing facts and circumstances, Petitioner is damaged and will continue to be damaged by the continuing existence of Reg. No. 2,227,005, for the trademark GO GIRL.

WHEREFORE, it is respectfully requested that this Petition To Cancel be granted and that Reg. No. 2,227,005 be cancelled and stricken from the Federal Register.

Please charge the Petition To Cancel fee in the amount of \$300.00 for one class of goods, to Petitioner's attorney's Deposit Account No. 50-2658. This paper is filed in duplicate.

Respectfully submitted,

Dated: February 5, 2008
Sacramento, California

R. Michael West
R. Michael West
Attorney For Petitioner

The correspondence address, and
the telephone and facsimile numbers
for this communication are:

R. Michael West
The Law Offices Of
R. Michael West
455 Capitol Mall, Suite 405
Sacramento, California 95814
Telephone: (916)-444-5444
Facsimile: (916)-444-5441

CERTIFICATE OF MAILING

Date of Deposit: February 5, 2008

I hereby certify that the PETITION TO CANCEL, and associated paper(s) are being deposited with the United States Postal Service First Class Mail under 37 CFR 1.8 on the date indicated above and is addressed to Trademark Trial And Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451.

Dated: February 5, 2008 Lee Chase
Lee Chase

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing PETITION TO CANCEL was mailed First Class mail, postage prepaid, to Respondent's Counsel on: February 5, 2008 at the address indicated below:

Barry Soalt, Esq.
Procopio, Cory, Hargreaves & Savitch LLP
530 B Street, Suite 2100
San Diego, California 92101-4469

Dated: February 5, 2008 Lee Chase
Lee Chase